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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/141,264	08/27/1998	TERRELL B. JONES	7099.0003	9665

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FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER	
GARG, YOGESH C	
ART UNIT	PAPER NUMBER
3625	

DATE MAILED: 03/26/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary	Application No.	Applicant(s)	
	09/141,264	JONES ET AL.	
	Examiner	Art Unit	
	Yogesh C Garg	3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for R ply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 April 2001* .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-59* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-59* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☒ Interview Summary (PTO-413) Paper No(s). *11* .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

1. Applicant is advised that the Notice of Allowance mailed is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.

2. Prosecution on the merits of this application is reopened on claims 1-59 considered unpatentable for the reasons indicated below:

Response to Arguments/Amendment

3. Applicant's arguments with respect to claims 1-57, filed in Amendment D, paper number 9, on 04/18/2001, have been considered but they are not persuasive. Applicant argues that DeLorme et al. does not disclose, at least, receiving a travel goal having a destination location and appointment time or determining an arrival time within a vicinity of the destination location that allows time for traveling between the intermediate point and the destination location to ensure arrival at the destination location by the appointment time as required by independent claims 1,20, and 30. The examiner does

not agree. Delorme et al. does teach that TRIPS system " intelligent software" uses a time frame to determine an arrival time within a vicinity of the destination location to ensure arrival at the destination location by the appointment time; see at least column 17, line 62-column 18, line 12. For a traveler like John Jones going on either a business or family trip presents a travel goal to attend his grandmother's birthday party at the appointed time between 5:30-7:30 PM to the TRIPS and TRIPS then builds and optimizes the trip on this basis and this building and optimizing of the trip would inherently involve considering the time required to travel between the grandmother's party's location and the nearest air terminal, bus-station or train station, which form the intermediate points (waypoints in Delorme) before the destination location of the grandmother's party, as further disclosed in column 34, line 57-column 35, line 8. TRIPS "intelligent" software shapes the plane flights based upon the time/date frame indicated by John Jones and that would inherently require to determine the arrival time at the airport, which is the intermediate point and in vicinity of the destination of the grandmother's party location, such that he has sufficient time to travel between the airport-the intermediate point-to the destination location at the appointed time. Also see column 8, lines 33-39, and column 40, line 57-column 41, line 5. TRIPS system determines a travel route keeping in view the intermediate points before arriving at the destination location. Note: the travel destination, and desired waypoints in Delorme correspond to the destination location and intermediate points respectively in the application.

Applicant's arguments with respect to claims 58-59, filed in Amendment D, paper number 9, on 04/18/2001, have been considered but they are moot in view of the new ground(s) of rejection.

This is a non-final rejection.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 59 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In the preamble of claim 59, the intended meaning of the phrase "computational entity being executed by a processor " is unclear. A telephonic interview was conducted with Attorney Mr. Joe Palys on 10/10/2002 and it was agreed to deplete the existing preamble " A memory for access by a computational entity being executed by a processor including:" and insert therefore -- A memory for access by a computer including:--. Since the examiner's amendment was not sent we suggest that this change is made. Copy of interview summary is attached. For art rejection the suggested preamble has been considered.

Double Patenting

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1-59 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-59 of co-pending Application No. 10/141,935. Although the conflicting claims are not identical, they are not patentably distinct from each other. The only difference in the claims 1-57 of both the applications is that claim limitations in the instant application include the phrase “that allows time for traveling between the intermediate point and the destination location”. This property would be inherent in the existing claim of the co-pending application ‘ 935, while determining an arrival time within a vicinity of the destination location using the located travel information to ensure arrival at the destination location by the appointment time.

The only difference between claim 58 of both the applications is that the co-pending application '935 does not include the phrase, " to ensure arrival at the destination location by the appointment time. However, this limitation would be obvious over the existing claim of the co-pending application ' 935 while recommending a plurality of travel options and recommending a plurality of secondary modes of transportation based on the travel goal to reach the destination location at an appointed time.

The only difference between claim 59 of both the applications is that the co-pending application '935 includes the phrase " select ground transportation " instead of "recommend one or more modes of ground transportation " as included in the instant application. However, the limitation of recommending one or more ground transportation would be obvious over the existing claim of the co-pending application ' 935 to enable the user to select one of the modes.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

8. Recent Statutory Changes to 35 U.S.C. § 102(e)

On November 2, 2002, President Bush signed the 21st Century Department of Justice Appropriations Authorization Act (H.R. 2215) (Pub. L. 107-273, 116 Stat. 1758 (2002)), which further amended 35 U.S.C. § 102(e), as revised by the American Inventors Protection Act of 1999 (AIPA) (Pub. L. 106-113, 113 Stat. 1501 (1999)). The revised provisions in 35 U.S.C. § 102(e) are completely retroactive and effective immediately for all applications being examined or patents being reexamined. Until all of the Office's automated systems are updated

to reflect the revised statute, citation to the revised statute in Office actions is provided by this attachment. This attachment also substitutes for any citation of the text of 35 U.S.C. § 102(e), if made, in the attached Office action.

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 in view of the AIPA and H.R. 2215 that forms the basis for the rejections under this section made in the attached Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.**

35 U.S.C. § 102(e), as revised by the AIPA and H.R. 2215, applies to all qualifying references, except when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. For such patents, the prior art date is determined under 35 U.S.C. § 102(e) as it existed prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. § 102(e)).

The following is a quotation of the appropriate paragraph of 35 U.S.C. § 102 prior to the amendment by the AIPA that forms the basis for the rejections under this section made in the attached Office action:

> **A person shall be entitled to a patent unless –**
>
> **(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.**

For more information on revised 35 U.S.C. § 102(e) visit the USPTO website at www.uspto.gov or call the Office of Patent Legal Administration at (703) 305-1622.

9. Claims 1-57 are rejected under 35 U.S.C. 102(e) as being anticipated by DeLorme et al, U.S. Patent No. 5,948,040.

Regarding claim 1, DeLorme discloses a data processing system for processing travel requests using a travel database, comprising:

a memory including program instructions (column 14, lines 53-65); and a processor operating responsive to the program instructions to (column 14, lines 53-65): receive a travel goal specifying a destination location and an appointment time for arrival at the destination location (column,17, line 62-column,18, line 12, column 23, lines 14-63; column 26, lines 29-55; and column 40, lines 54-55; column 50, lines 30-35);

access the travel database to locate travel information corresponding to the destination location (column 13, line 48-column 14, line 52); and

determine an arrival time at an intermediate point within a vicinity of the destination location using the located travel information to ensure arrival at the destination location by the appointment time (column 8, lines 33-39,column34, line 57-column 35, line 8, column 40, line 57-column 41, line 5, column 51, lines 31-36 and column 19, lines 39-58).

Regarding claim 2, DeLorme further discloses a plurality of travel stations are within the vicinity of the destination location, and wherein the processor further operates responsive to the program instructions to:

select one of the plurality of travel stations (column 18, line 58-column 19, line 8); and determine available modes of transportation between the selected travel station and the destination location (column 8, lines 33-58).

Regarding claim 3, DeLorme further discloses the processor further operates responsive to the program instructions to:

display the available modes of transportation (column 23, lines 45-63); and receive a selection of one of the available modes of transportation (column 18, line 58-column 19, line 8).

Regarding claim 4, DeLorme further discloses the travel information includes a plurality of travel options available at the travel station, and wherein the processor further operates responsive to the program instructions to:

select one of the plurality of travel options that arrives at the travel station at the time of arrival sufficient to ensure arrival at the destination location by the appointment time (column 17, lines 44-60).

Regarding claim 5, DeLorme further discloses the processor further operates responsive to the program instructions to display data listing the plurality of travel options (column 25, lines 35-65); and receives an indication of a selected travel conveyance (column 40, lines 38-56).

Regarding claim 6, DeLorme further discloses the processor further operates responsive to the program instructions to:

display data listing the plurality of travel options (column 25, lines 35-65); and receive an indication of a selected travel flight (column 40, lines 48-50).

Regarding claim 7, DeLorme further discloses the instructions to maintain a profile of travel preferences, wherein the travel option section is based on the travel preferences (column 61, lines 10-26).

Regarding claim 8, DeLorme further discloses the processor further operates responsive to the program instructions to:

receive a travel return date (column 51, line 23-column 52, line 23); and display a list of return travel options from the travel station on the travel return date (column 51, line 23-column 52, line 23).

Regarding claim 9, DeLorme further discloses the processor further operates responsive to the program instructions to:
determine whether an overnight stay is required (column 17, lines 55-58 and column 18, lines 48-51); and display a list of hotels for selection (column 22, lines 43-51).

Regarding claim 10, DeLorme further discloses the processor further operates responsive to the program instructions to:

receive a selection of one of the hotels (column 74, lines 20-25); and reserve a room at the selected hotel (column 74, lines 20-25).

Regarding claim 11, DeLorme further discloses the processor further operates responsive to the program instructions to locate restaurants in a vicinity of the destination site (column 49, line 60-column 50, line 26).

Regarding claim 12, DeLorme further discloses the processor further operates responsive to the program instructions to search a restaurant database for restaurants in the vicinity of the destination location (column 48, lines 47-67).

Regarding claim 13, DeLorme further discloses the processor further operates responsive to the program instructions to locate restaurants includes an instruction to display the determined restaurants (column 50, lines 27-67).

Regarding claim 14, DeLorme further discloses the processor further operates responsive to the program instructions to locate activities in a vicinity of the destination location (see figures 7A and 7B).

Regarding claim 15, DeLorme further discloses the processor further operates responsive to the program instructions to: search an activities database for the activities in the vicinity of the destination location (column 30, lines 1-17).

Regarding claim 16, DeLorme further discloses the processor further operates responsive to the program instructions to: locate activities includes an instruction to display a list of the determined activities (figures 7A and 7B).

Regarding claim 17, DeLorme further discloses the processor further operates responsive to the program instructions to provide travel information in accordance with the determined arrival time (column 17, lines 14-43).

Regarding claim 18, DeLorme further discloses the travel information includes geographic data for travel between the travel station and the destination (figures 1B-1C).

Regarding claim 19, DeLorme further discloses the travel goal may include a plurality of legs of travel each leg of travel including a different destination location and appointment time for arrival at the destination location (column 44, lines 43-61).

Claims 20-38 are written in computer software with parallel limitations found in claims 1-19, therefore are rejected by the same rationale.

Claims 39-57 are written in function method with parallel limitations found in claims 1-19, therefore are rejected by the same rationale.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 58-59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Delorme and further in view of, Press release, " ICL NETS CONTRACT FOR BIRMINGHAM TRANSIT INFO SYSTEM ", Intelligent Highway, v5, n2, pN/A, May 1, 1993, 1 page, word count 399, from Dialog database, Item 9 from file 16, document number 02834213, supplier number 43812678, extracted on Internet on 01/20/2003, hereinafter, referred to as Press release.

Regarding claim 58, DeLorme discloses a method for processing travel requests including the steps of:

receiving a travel goal including a destination location and an appointment time (column,17, line 62-column,18, line 12, column 23, lines 14-63; column 26, lines 29-55; and column 40, lines 54-55; column 50, lines 30-35);

recommending a plurality of travel options and recommending a secondary mode of transportation based on the travel goal to ensure arrival at the destination location by the appointment time (column 17, lines 44-60; column 40, lines 38-56 and figures 7A-7B, column 8, lines 33-39,column 34, line 57-column 35, line 8, column 40, line 57-

column 41, line 5, column 51, lines 31-36 and column 19, lines 39-58. Note: car rentals correspond to the secondary mode of transportation).

invoking a transportation decision system to select one of the plurality of travel options and a secondary mode of ground transportation based on the recommended travel options and the recommended secondary ground transportation (column 14, lines 19-43, col.21, lines 63-66, col.23, lines 56-63);

determining whether an overnight stay is required (column 17, lines 55-58 and column 18, lines 48-51);

invoking a hotel decision support system to select a hotel when it is determined that an overnight stay is required (figures 7A-7B); and

invoking an activity and restaurant decision support system to select activities and restaurants in a vicinity of the destination location (figures 7A-7B).

DeLorme further teaches selection of a plurality of secondary modes of transportation, see col.21, lines 63-66, col.23, lines 56-63. TRIPS discloses other modes of transportation like, walking, subway, biking, plane, car, public transport which can be made available to the user to select. Delorme does not disclose recommending a plurality of second modes of transportation to ensure arrival at the destination location by the appointment time. However, Press release, teaches recommending alternative transportation modes to passengers on interactive terminals (see the entire article, *".....The system will also recommend alternative transportation modes and routes to passengers* "). By recommending alternative plurality of transportation modes like buses and trains the system will be able to provide the best information on expected delays,

arrival times of the busses and enabling the passengers to calculate transit routes both by bus and train to their selected destinations. In view of the Press release, it would be obvious to a person of an ordinary skill in the art at the time of the invention to modify Delorme to include recommending alternative transportation modes to the user to enable him calculate the transit route and select the one as per his preference to reach his destination.

Regarding claim 59, DeLorme discloses a memory for access by a computer including:

a travel goal subsystem for receiving a travel goal including a destination location and an appointment time (column,17, line 62-column,18, line 12, column 23, lines 14-63; column 26, lines 29-55; and column 40, lines 54-55; column 50, lines 30-35);

a transportation subsystem having instructions to select modes and times of transportation based on the travel goal (figures 2, items 221 and 223);

a hotel subsystem having instructions to select hotel in a vicinity of a destination site (figure 2, item 213);

activity and restaurant subsystem having instructions to select activities or restaurants near a destination site (figure 2, item 213);

DeLorme further teaches a subsystem for selection of a plurality of secondary modes of transportation, see col.21, lines 63-66, col.23, lines 56-63. TRIPS discloses other modes of transportation like, walking, subway, biking, plane, car, public transport which can be made available to the user to select. Delorme does not disclose a ground

transportation subsystem having instructions to recommend one or more modes of ground transportation to a destination site. However, Press release, teaches ground transportation subsystem having instructions to recommend one or more modes of ground transportation to a destination site to passengers on interactive terminals (see the entire article, "*.....The system will also recommend alternative transportation modes and routes to passengers* "). By recommending one or more modes of ground transportation like buses and trains the system will be able to provide the best information on expected delays, arrival times of the busses and enabling the passengers to calculate transit routes both by bus and train to their selected destinations. In view of the Press release, it would be obvious to a person of an ordinary skill in the art at the time of the invention to modify Delorme to include recommending one or modes of transportation to the user to enable him calculate the transit route and select the one as per his preference to reach his destination.

Conclusion

12. This is a non-final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone

numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg
Examiner
Art Unit 3625

YCG
January 21, 2003

WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600